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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 051104

Application Number: 10/036,708
Filing Date: December 21, 2001
Appellant(s): MERCURE ET AL.

MAILED

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GROUP 1700

Daniel Nguyen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 30, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

A statement that claims 1-4, 6-18, 20-24 and 27-29 stand or fall together is present in the Appellant's brief.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-18, 20-24, and 27-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wynne et al. (US 5,328,743). Wynne et al. (US 5,328,743) teaches a reinforced shrink wrap that is multilayered with reinforcing grids in adhesive layers on either side of a shrink film with outer layers of olefin film (abstract). The shrink film layer is highly irradiated polyethylene and the preferred thickness is from 0.75 mil to 1.5 mils (col 2, ln 22-25). The outer layers of the shrink wrap is a polyolefin film from 1 to 6 mil thick and may have two plies or more (col 2, ln 48-49 and 54). The polyolefin layers can include additives such as color additives, antioxidants, ultraviolet light stabilizers, and corrosion inhibitors (col 3, ln 15-22). In addition, additives used in polyolefin film may be included as desired in the polyolefin inner or outer layers or in one of more plies of a multiply film. Additives include ultraviolet light stabilizers and flame retardants (col 1, ln 52-58). The reinforcing grid is preferably 200 to 800 denier yarn in a crisscross pattern which the Examiner equates to be the non-woven scrim of Applicant's invention. The grid is filamentous made of single strand or multiple filament yarn preferably nylon, polyester or blends (col 2, ln 28-31). The reinforcing grid is in a layer of adhesive. The adhesive has a dry thickness of between 0.25 and 1 mil and should be used in an effective amount to prevent delamination (col 2, ln 31-36). There can be more than one adhesive layer (col 4, ln 12-14). It should be noted that the Examiner is equating Wynne's adhesive layer to Appellant's tie layer. It should also be noted that Appellant's specification, on page 8, describes the tie layer as a methyl acrylate. Wynne et al. discloses that the adhesive is an acrylic based

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adhesive (col 4, ln 9-12). Therefore, the tie layer of Appellant's invention and the adhesive of Wynne et al. will have the same properties when extruded. Inherently, the adhesive of Wynne et al. will have a lower modulus than the outer polyolefin layers since the adhesive is not used in an amount that retards the movement of the grid and because the grid sags to prevent tearing.

Appellant's claims read on an "extrusion laminated" shrink wrap. Wynne et al. fail to disclose that the shrink wrap is extrusion-laminated. Wynne does disclose that the outer layers are co-extruded (col 5, ln 10-12 and ln 21-23). It should be noted that the method of forming an article is not germane to the issue of patentability of the article itself. Furthermore, it is not seen how extrusion laminating the shrink wrap significantly affects the chemistry or structure of the shrink wrap itself. It is the examiner's position that the shrink wrap of Wynne et al. is identical to or only slightly different than the claimed shrink wrap prepared by the method of the claims, because both shrink wraps comprise a first layer of thermoplastic material, a second layer of thermoplastic material, a reinforcing grid disposed between the first and second layers of thermoplastic and an adhesive of elastomeric material. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to Appellant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). The Wynne et al. either anticipated or strongly suggested the claimed

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subject matter. In the event any difference can be shown for the shrink wrap of the product-by process claims 1-4, 6-18, 20-24, and 27-29, as opposed to the product taught by the Wynne et al. reference, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

(11) Response to Argument

Appellant argues that Wynne et al. do not disclose a tie layer a. This argument is not persuasive because Wynne's reinforcing grid is in a layer of adhesive which has the same properties as Appellant's tie layer, e.g. prevents delamination. Furthermore, as shown above, Wynne's adhesive is an acrylic-based adhesive and Appellant's tie layer is a methyl acrylate. Therefore, because Wynne's adhesive is made of the same material and has the same thickness, it is the Examiner's position that Wynne's adhesive and Appellant's tie layer are the same material, but just have a different name. Appellant also argues that the tie layer and the adhesive layer result in different properties. It is the Examiner's position that the Table 1 comparison of a tie layer and adhesive layer is not a fair comparison. The tie layer in Table 1 has a thickness of 8.3 mils, whereas the adhesive layer has a thickness of 6.4. It is well known that the thicker an adhesive layer is directly affects the lamination strength of the composite. Therefore, because a fair comparison has not been done (i.e. comparing a tie layer and an adhesive layer having the same thickness), the Examiner maintains that the adhesive layer of Wynne et al. is not functionally different from Appellant's adhesive layer.

Appellant also argues that Wynne et al. do not disclose using extrusion-lamination. This argument is also not persuasive because, as shown above, Wynne et al. do disclose that the outer layers are co-extruded (col 5, ln 10-12 and ln 21-23). Furthermore, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Appellant also argues that Table 1 shows that Appellant's invention results in a different product than those disclosed in Wynne. This argument is not persuasive because, as discussed above, Table 1 is an unfair comparison between the Wynne et al. reference and Appellant's invention.

Appellant also argues that there is no motivation to make a reinforced shrink wrap with a tie layer. This argument is not persuasive because, as discussed above, the Examiner is equating Wynne's adhesive layer to the Appellant's tie layer. It is the Examiner's position that this layer can be described by both names, i.e. an adhesive layer or a tie layer.

Appellant also argues that the claimed invention results in unexpectedly improved properties or properties that are not present in the prior art. This argument is not persuasive because the lamination strength comparison done in Appellant's declaration is not commensurate in scope with the claims because the lamination strength of the shrink wrap has not been claimed. Furthermore, the comparison of the 3" Load @ Yield of the shrink wrap made with either an

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adhesive or tie layer is an unfair comparison because the tie layer has a thickness that is significantly greater than the thickness of the adhesive.

Appellant argues that their use of an extrusion-lamination process to make a shrink wrap goes against convention wisdom. This argument is not persuasive because Wynne et al. discloses a shrink wrap wherein the outer layers are coextruded (col 5, ln 10-12). Therefore, it is not against conventional wisdom to extrude shrink wrap layers.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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May 12, 2004

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